

REMARKS

I. Rejection under Section 102(b) Based on Gerspacher et al.

In the Office Action, claims 60-62 were rejected under 35 U.S.C. § 102(b) based on U.S. Patent No. 4,143,209 to Gerspacher et al. ("Gerspacher"). Applicants respectfully traverse the § 102(b) rejection because 1) the rejection statement fails to properly consider the all of the subject matter recited in each of those claims, and 2) when all of the subject matter is properly considered, the Gerspacher reference fails to disclose or suggest all of the subject matter recited in each of claims 60-62.

The rejection statement asserts that claims 60-62 are product-by-process claims, and further, that since they are product-by-process claims, the subject matter recited in the claims that relates to the process does not need to be considered when examined with respect to the prior art. Office Action at 2-3 (citing M.P.E.P. § 2113 in purported support).

Applicants respectfully submit that none of claims 60-62 is a product-by-process claim. Rather, each of claims 60-62 is a dependent claim that depends from independent claim 32, which recites a "method for producing a metal wire for reinforcing an elastomeric material" Since a dependent claim must necessarily include the subject matter recited in it's corresponding independent claim, each of claims 60-62, when properly interpreted, must necessarily include all of the subject matter recited in independent claim 32. See M.P.E.P. § 608.01(n)(III). Further, dependent claim 61 is not directed to a product. Rather, dependent claim 61 is directed to a "method for producing a metal cord for reinforcing an elastomeric material" For at least this additional reason, dependent claim 61 cannot be a product-by-process claim.

Therefore, each of dependent claims 60-62 should be interpreted as including the subject matter recited in corresponding independent claim 32, and under this proper interpretation, the subject matter relating to the process cannot be completely disregarded when examining these claims with respect to the prior art by virtue of mischaracterizing these claims as product-by-process claims.

When each of claims 60-62 is properly interpreted to include the subject matter recited in independent claim 32, the Gerspacher reference fails disclose or suggest all of the subject matter recited in each of claims 60-62. The Office Action implicitly concedes that Gerspacher does not disclose or suggest all of the subject matter recited in each of those claims by virtue of the Office Action's failure to include a rejection under 35 U.S.C. § 102(b) or § 103(a) of independent claim 32 based on Gerspacher. For at least these reasons, Applicants respectfully submit that each of dependent claims 60-62 is patentably distinguishable from Gerspacher. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 60-62 under § 102(b) based on Gerspacher.

II. Rejection under Section 103(a) based on Gerspacher and Sawada et al.

Claims 32-59 were rejected under § 103(a) as being unpatentable over Gerspacher in view of U.S. Patent No. 4,859,811 to Sawada et al. ("Sawada"). Claim 32 is the only independent claim included in this rejection. Applicants respectfully traverse the § 103(a) rejection of independent claim 32 because the Office Action has failed to establish a *prima facie* case of obviousness.

According to the M.P.E.P., in order to establish a *prima facie* case of obviousness, "the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (D) Reasonable expectation of success is the standard with which obviousness is determined.

§ 2141(II) (citation omitted). Thus, the claimed invention as a whole, rather than merely the subject matter not disclosed in a base reference, must be analyzed with respect to the prior art references as a whole. Further, the prior art references themselves, without the benefit of hindsight and Applicants' own disclosure, must suggest the desirability of modifying the base reference. Further, when the base reference teaches away from the modification, the modification is not obvious. See § 2145(X)(D)(2). Moreover, unless a person having ordinary skill in the base reference's art would reasonably be expected to look to the secondary reference's art to solve a problem associated with the base reference's art, the secondary reference is not analogous art and cannot be used to modify the base reference's teachings. See § 2141.01(a)(IV).

Applicant respectfully traverses the § 103(a) claim rejection and respectfully submits that Gerspacher teaches away from the Office Action's proposed, hypothetical modification to Gerspacher based on Sawada, and further, that an ordinary artisan in Gerspacher's art relating to wire reinforcement of tires would not look to Sawada's art relating to high quality electrical conductors for use in magnetic coils, acoustic- and image-forming appliances, such as stereo equipment, and for connecting semiconductor elements in an integrated circuit.

In the Office Action, the rejection statement concedes that "Gerspacher uses an electroplating process for obtaining adhesion of a coating to the core" rather than "the coating material [being] deposited on the on the metal core . . . using a plasma deposition technique," as recited in independent claim 32. Office Action at 3. The rejection statement asserts, however, that "it would have been obvious to . . . have modified Gerspacher's coating process by using a plasma or sputtering deposition process," purportedly because Sawada shows a plasma deposition process to "facilitate greater adhesion advantages." Id.

Applicants respectfully disagree with the rejection statement's obviousness assertions. Rather than disclosing "a plasma or sputtering deposition process," Gerspacher discloses a process for making rubber-adherable wire for reinforcing rubber articles, such as tires, using an electroplating process. Indeed, Gerspacher discloses that electrodeposition is the "preferred" process. See, e.g., col. 3, lines 65-66. Thus, Gerspacher teaches away from substituting "a plasma or sputtering deposition process" for the "preferred" electroplating process. For at least this reason, it would not have

been obvious to modify the Gerspacher reference's process for making zinc-coated steel wire for reinforcing tires based Sawada's disclosure.

In addition to teaching away from the rejection statement's proposed, hypothetical modification to Gerspacher's disclosed process, the rejection statement's proposed modification is improper under § 103(a) because a person having ordinary skill in Gerspacher's art relating to processes for making wire for reinforcing tires would not have looked to Sawada's disclosure relating to processes for making high quality electrical conductor for use in winding magnet coils, acoustic- and image-forming appliances, such as stereos, and for connecting semiconductor elements in integrated circuits. According to the M.P.E.P., unless a person having ordinary skill in a base reference's art, seeking to solve a problem known in the art of the base reference would reasonably be expected to look to the secondary reference's art, the secondary reference is non-analogous art. § 2141.01(a)(IV). Moreover, if a reference is non-analogous art, it cannot be relied on a claim rejection under 35 U.S.C. § 103(a). § 2141.01(a).

Applicants respectfully submit that there is no reason an ordinary artisan skilled in Gerspacher's art relating to processes for making wire for reinforcing tires would reasonably be expected to look to the art of making high quality electric conductors for audio devices and integrated circuits. Indeed, Gerspacher is concerned with the problem of improving the adhesion between the wire and the elastomeric material of tires. In contrast, Sawada is concerned primarily with the problem of improving the quality and reliability of an electrical conductor, along with reducing the diameter of the electrical conductor. Thus, it is not reasonable to expect that an artisan in Gerspacher's

field of reinforcing wires would look to Sawada's electrical conductor field to solve a problem purportedly known in Gerspacher's field. Thus, Sawada is non-analogous art. For at least this additional reason, the Gerspacher and Sawada references, when viewed as a whole, do not render Applicants' independent claim 32, viewed as a whole, *prima facie* obvious.

III. Rejection of Dependent Claims

Dependent claims 33-59 were rejected under 35 U.S.C. § 103(a) based on Gerspacher in combination with Sawada, and claims 60-62 were rejected under 35 U.S.C. § 102(b) based on Gerspacher alone, as outlined previously herein. All of these claims depend from independent claim 32, so they should be patentably distinguishable from Gerspacher and Sawada, regardless of whether they are viewed individually or in combination, for at least the same reasons as independent claim 32. Thus, dependent claims 33-62 should be allowable for at least the same reasons independent claim 32 is allowable.

IV. Conclusion

As outlined above, independent claim 32 should be allowable. Dependent claims 33-62 depend from allowable independent claim 32. Therefore, each of those dependent claims should be allowable for the same reasons independent claim 32 is allowable, as well as by virtue of their recitations of additional novel and non-obvious subject matter.

Applicants respectfully request reconsideration of this application, withdrawal of the outstanding claim rejections, and allowance of claims 32-62.

If the Examiner believes that a telephone conversation might advance prosecution, the Examiner is cordially invited to call Applicants' undersigned attorney at (404) 653-6559.

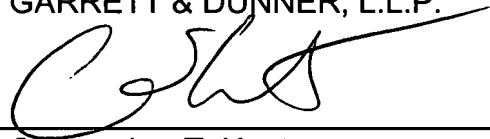
Applicants respectfully submit that the Office Action contains a number of assertions concerning the related art and the claims. Regardless of whether those assertions are addressed specifically herein, Applicants respectfully decline to automatically subscribe to them.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account 6-0916.

Respectfully submitted,

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By: 

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